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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,458	08/22/2000	Daniel T. Mytych	JB0976Q	9578

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SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1, 1990)
2000 GALLOPING HILL ROAD
KENILWORTH, NJ 07033-0530

EXAMINER

LI, BAO Q

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 10/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/643,458

Applicant(s)

MYTYCH ET AL.

Examiner

Bao Qun Li

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-20 are pending.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to a method for detecting an antibody against adenovirus by using a single antigenic peptide in BIACORE system, classified in class 435, subclass 5.

Upon considering election of group I, a further restriction and election for one single sequence is required under 35 U.S.C. 121:

- i). SEQ ID NO: 1. ii). SEQ ID NO: 2. iii). SEQ ID NO: 3. iv). SEQ ID NO: 4. v). SEQ ID NO: 5. vi). SEQ ID NO: 6. vii). SEQ ID NO: 7. viii). SEQ ID NO: 9. ix). SEQ ID NO: 10. x). SEQ ID NO: 11. xi). SEQ ID NO: 12. xii). SEQ ID NO: 13. xiii). SEQ ID NO: 14. xiv). SEQ ID NO: 15.
- II. Claims 8-15, drawn to a method for detecting anti-adenovirus antibodies by using a plurality of antigenic peptides in BIACORE system, classified in class 435, subclass 7.1.

Upon considering election of group II, a further restriction and election for one set of plurality sequences of 7 SEQ ID Nos are required under 35 U.S.C. 121:

- i). SEQ ID NO: 1. ii). SEQ ID NO: 2. iii). SEQ ID NO: 3. iv). SEQ ID NO: 4. v). SEQ ID NO: 5. vi). SEQ ID NO: 6. vii). SEQ ID NO: 7. viii). SEQ ID NO: 8. ix). SEQ ID NO: 9. x). SEQ ID NO: 10. xi). SEQ ID NO: 11. xii). SEQ ID NO: 12. xiii). SEQ ID NO: 13. xiv). SEQ ID NO: 14. xv). SEQ ID NO: 15.

- III. Claims 16-18, drawn to a method for detecting anti-adenovirus antibodies by using ELISA system, classified in class 435, subclass 7.72.

Upon considering election of group III, a further restriction and election for one single sequence is required under 35 U.S.C. 121:

- i). SEQ ID NO: 1. ii). SEQ ID NO: 2. iii). SEQ ID NO: 3. iv). SEQ ID NO: 4. v). SEQ ID NO: 5. vi). SEQ ID NO: 6. vii). SEQ ID NO: 7.

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- IV. Claim 19, drawn to a composition comprising SEQ ID NO: 8, classified in class 424, subclass 185.1.
- V. Claim 20, drawn to a method of detecting an antibody, classified in class 435, subclass 4 .

The inventions are distinct, each from the other because of the following reasons:

Inventions of different Groups of i) to xiv) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to structurally different molecules exhibiting different antigenicities, e.g. the SEQ ID NO: 1 different from any of rest of sequences from SEQ ID NO: 2 to 7 or 9 to 15.

Inventions of groups I-III and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions are directed to structurally different agents used for different purpose and produce different biological effects, e.g. the product of Group I is an isolated polypeptide HCV different methods, e.g. the method of Group I uses one peptide for detecting an antibody against adenovirus, whereas, the method of Group II uses plurality of peptides for detecting antibodies against adenovirus.

Inventions I and IV are related as process of using and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be practiced with materially different product or (2) that the product as claimed can be practiced by another and materially different process (MPEP § 806.05(f)). In the instant case, the process as claimed can be practiced with materially different product, such as SEQ ID NO: 1, rather than SEQ ID NO: 8.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the literature and sequence searches required for one of the Groups are not required for another one of the Groups, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao Qun Li whose telephone number is 703-305-1695. The examiner can normally be reached on 7:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 703-308-4027. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

A handwritten signature in cursive script, appearing to read 'Bao Qun Li', written in black ink.

Bao Qun Li

September 30, 2003